

Remarks

Reconsideration of the application and allowance of all claims pending are respectfully requested. Claims 1-10 are pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Claim Rejections - 35 U.S.C. §103

Claims 1-3, 5-8 and 10 were rejected under 35 U.S.C. §103 as being unpatentable over O'Sullivan (U.S. Patent No. 7,212,516) in view of Morganstein (U.S. Patent No. 5,940,476). This rejection is respectfully traversed.

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*" (Emphasis added.)

Claim 1

Claim 1 is directed to the method for providing Internet protocol telephone set subscribers with call features provided by a public switched telephone network (PSTN) switch. A packet is

received at the IP peripheral unit which is part of the PSTN switch where the packet contains a request for a first call feature. The IP peripheral unit transmits a second message to a packet line trunk unit of a switch module of the PSTN switch where the second message contains the request for the first call feature. An applications processor contained in the PSTN switch accesses first information contained in a directory database based on the request of the first call feature of the second message. The applications processor retrieves at least a portion of the first information. The PSTN switch transmits the at least portion of the first information to an IP telephone set subscriber in response to the request for the first call feature.

An important consideration in accordance with the invention of claim 1 is that the PSTN switch itself provides call features to IP telephone set subscribers. As explained in the Background of the subject application, it is believed that prior to the subject invention a full array of call features was not available to IP telephone set subscribers directly from a PSTN switch. One reason why such services were not available is that a connecting PBX was unable to communicate with the applications processor of the supporting PSTN switch, whereby call processing services only available through the applications processor/PSTN switch could not be accessed by IP telephone set subscribers. O'Sullivan, Morganstein, or the combination thereof do not teach the steps required accordance claim 1 or provide the advantage of providing direct support to IP telephone set subscribers of call features that are available to other circuit subscribers of the PSTN switch.

O'Sullivan is directed to call centers that support both circuit switched and Internet protocol traffic; see column 1, lines 8-10. One of ordinary skill of the art will understand that a call center functions as a specialized private branch exchange (PBX) in which a plurality of incoming calls are distributed among a plurality of service agents. The described network spanning heterogeneous call center 500 is designed to distribute incoming calls from both a circuit switched environment and a VOIP environment to a common set of service agents. However, since it is not a PSTN based switch, the network spanning heterogeneous call center cannot receive the call events/messages available in the PSTN switch and hence cannot provide the call features that require access to such events/messages of the PSTN switch.

Claim 1 is directed to the method implemented by a PSTN switch wherein IP telephone set subscribers are provided with call features by the switch. In the Office Action it is stated:

O'Sullivan discloses a method for a PSTN call center (500 of FIG. 5; Column 6, lines 25-34; viewed as a PSTN switch) to provide Internet telephone users with call features (column 6, lines 47-51).

As explained above, the call center 500 of O'Sullivan is merely a specialized PBX, not a switch in the PSTN. The PSTN is clearly represented in FIG. 5 as network 18 to which the call center 500 is connected. One of ordinary skill in the art would understand from FIG. 5 that PSTN switches are disposed within network 18 and that the call center 500 functions as a PBX. Thus, one of ordinary skill in the art would not view the call center 500 as a switch in the PSTN. One of ordinary skill in the art would also know that a PBX, i.e. the call center 500, is not equivalent to a PSTN switch, e.g. the PBX is not granted access to internal events/messages generated by a PSTN switch. The Office Action improperly characterizes the call center 500 as a PSTN switch, and therefore *prima facie* grounds for the rejection of claim 1 have not been established.

It is known that a PBX will offer some call features to its subscribers. However, the PBX call features are typically generated totally internal to the PBX. That is, since the PBX does not have access to the call events/messages internal to a PSTN switch, call features that require the use of the call events/messages internal to a PSTN switch cannot be provided by the PBX.

Morganstein is directed to techniques associated with identifying an unidentified caller. It is important to note that network 12 of Morganstein FIG. 1 is the PSTN and that the "switch" 20 is the organization's telephone switching system, i.e. a PBX; see column 2, lines 35-57. In Morganstein, the PBX 20 is coupled to a server 30 which is in turn coupled to a database server 34. It will be noted that PBX 20, server 30 and database server 34 are all part of the data communication system 10 utilized in Morganstein. It would be clear to one of ordinary skill in the art that the actions associated with these elements are not part of the PSTN 12, and are certainly not part of a PSTN switch.

The method of claim 1 implemented by the PSTN switch is not taught by O'Sullivan, Morganstein or the combination thereof. For example, neither O'Sullivan nor Morganstein teach or suggest how call features provided by a PSTN switch can be obtained by an IP telephone set subscriber. Both applied references relate to services provided by a PBX to subscribers coupled to the PBX. In this regard, neither reference is more relevant than the previous technology discussed in the Background of the subject application.

The rejection of claim 1 under 35 U.S.C. 103 based on O'Sullivan in view of Morganstein is requested to be withdrawn.

Claim 6

For similar reasons discussed above with regard to claim 1, the rejection of independent claim 6 under 35 U.S.C. 103 also based on O'Sullivan in view of Morganstein should be withdrawn.

Claims 1 and 6

Prior art teaches away

It is well-settled that teachings of a reference that teach away from a limitation of the claimed invention must be considered as well as teachings of the reference that could point towards the invention.

...an applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (CA FC 2003)

Both O'Sullivan and Morganstein teach away from the present invention of claim 1 and 6 in a material respect, i.e. both suggest that a PBX is the provider of services to subscribers. This prevents services available only through a PSTN switch from being provided to IP phone set

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subscribers. Hence, the *prima facie* case of obviousness made in the Office Action is rebutted and should be withdrawn.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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